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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,985	12/11/2003	Valerie M. Bennett	RSW920030204US1	4330
43168 7590 06/30/2011 MARCIA L. DOUBET LAW FIRM PO BOX 422859 KISSIMMEE, FL 34742				
EXAMINER				
HENRY, RODNEY M				
ART UNIT		PAPER NUMBER		
3682				
NOTIFICATION DATE		DELIVERY MODE		
06/30/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

### Office Action Summary

**Application No.**

10/733,985

**Applicant(s)**

BENNETT ET AL.

**Examiner**

RODNEY HENRY

**Art Unit**

3682

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/27/2011
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The following is a final, office action on the merits. The Examiner acknowledges the Applicant's reply dated 4/27/2011. Claims 7-12 were canceled. Therefore, Claims 1-6, and 13-26 are currently pending and have been considered below.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6, and 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-6, and 13-16, as best understood, it appears that the claimed method steps or processes are not statutory. Based on Supreme Court precedent<sup>1</sup> and Federal Circuit decisions a §101 process must

(1) be meaningfully tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup>

The independent claim is directed towards steps of "parsing", "registering", and "evaluating". Since the claims are directed to a method or a process without imposing

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advance. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

meaningful limits on the method claim's scope (beyond data gathering and outputting, as two examples), these claims are non-statutory.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1-4, 13-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Currans et al. (US 6731393), in view of Basrur (US 20040019589).**

As per Claim 1:

Currans et al. discloses a computer-implemented method of selectively subscribing to content in a computing environment, comprising:

responsive to selection, by a user from a view of content displayed on a graphical user interface from a source address, of a portion that comprises a subset of the displayed content

(see Currans (Detx 50)/col 15, lines 40-47.. As introduced above, this covert monitoring (via sensors, client application(s), etc.) records one or more of the distribution of content objects to a user, user receipt of content objects, whether the object(s) were printed or viewed on a display terminal, the duration viewed (if by terminal), whether any editing of the content object(s) occurred, and any other user

interaction with the content object(s)...(in whole or in part). The Examiner is construing the responses the user makes can be partial, i.e a subset, some or portion of interaction with the content. For example, printing some or the content, viewing some of the content, editing some of the content, etc.),

registering a subscription, for the user, to the selected portion of the content from the source address (see Currans FIG. 15 ..user registration and user subscription interests etc.); and

subsequently evaluating an updated version of the content from the source address, using the content selection document, to create an updated version of the selected portion.

(See Currans FIGS. 5, 7, 8 regarding customized newspaper (updated documents), etc. for the user. FIG. 2..documents can be requested from other sources)

Currans et al. does not explicitly disclose  
parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document;

However Basrur discloses  
parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document;

(see Basrur para. [0019] The parser 112 is included in the data access driver 110 to parse the markup language documents 120, 122, 128 and in some embodiments, to modify or even create the documents 120, 122, 128).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document to the system of Currans et al.. One would have been motivated to do this in order to develop customized documents for customers.

As per Claims 2, 18:

Currans et al. discloses using the registered subscription to deliver the updated version of the selected portion of the content to the user.  
(see Currans FIG. 7...personalized newspaper deliver 1:30 pm weekdays, and see FIG. 15 ..user registration and user subscription interests etc.).

As per Claims 3, 19:

Currans et al. discloses enabling the user to customize the subscription to specify at least one condition which must be matched before the user is interested in the updated version of the selected portion of the content (see Currans (Detx 46)/col 14, lines 54-59 ... If content objects identified for publication have already been retrieved to satisfy another user request, construction agent 520 access local memory 508 to quickly retrieve the identified content objects, block 1425. Otherwise, in block 1430,

construction agent 520 extracts the appropriate ones of the categorized content objects with which to generate a personalized publication); and

wherein the registering further comprises registering the customization (see Currans FIG. 7...personalized newspaper deliver 1:30 pm weekdays, and see FIG. 15 ..user registration and user subscription interests etc.).

As per Claims 4, 20:

Currans et al. discloses using the registered subscription to deliver the updated version of the selected an update of the identified portion of the content to the user only when the updated version matches at least one condition to the user (see Currans (Detx 10)/ col 6, lines 13-18... controller(s) 502 selectively invoke one or more of the virtual editor 506 to generate a custom document for a requesting and/or subscribing user, or publishing agent 504 to complete the layout and optimize the delivery schedule of such custom documents (Detx 46)/col 14, lines 54-59 ... If content objects identified for publication have already been retrieved to satisfy another user request, construction agent 520 access local memory 508 to quickly retrieve the identified content objects, block 1425. Otherwise, in block 1430, construction agent 520 extracts the appropriate ones of the categorized content objects (matching) with which to generate a personalized publication).

As per Claim 13:

Currans et al. discloses the view is a Web page.

(see Currans ..Detx10/col 6, lines 13-18 ... Controller(s) 502 may initiate construction and/or delivery of a custom document in response to user interaction with a user interface (e.g., a web page)).

As per Claims 14, 25:

Currans et al. discloses the Web page lacks a subscription mechanism (see Currans (detx 10)/ col 6, lines 10-30.. controller(s) 502 selectively invoke one or more of the virtual editor 506 to generate a custom document for a requesting and/or subscribing user, or publishing agent 504 to complete the layout and optimize the delivery schedule of such custom documents. Controller(s) 502 may initiate construction and/or delivery of a custom document in response to user interaction with a user interface (e.g., a web page), or to accommodate a user-selected delivery schedule. In this regard, controller 502 communicates with external applications (e.g., web page) or other elements (e.g., a user profile) via input/output (I/O) interface(s) 510. In an alternate embodiment, controller 502 provides a user with a user interface with which to request/build a custom document using one or more of applications 512.

(From the above one sees a web page that can cater to requesting/no subscribing users)).

As per Claim 15:

Currans et al. does not explicitly disclose the content selection document is a markup language document.



However Basrur discloses  
the content selection document is a markup language document

(see Basrur para. [0019] The parser 112 is included in the data access driver 110 to parse the markup language documents 120, 122, 128).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add to the system of Currans et al.. One would have been motivated to do this in order to develop customized documents for customers.

As per Claims 16, 26:

Currans et al. discloses the generating further comprises:  
determining a physical layout of the displayed content created from the parsed markup language document;  
determining a physical position of the portion selected by the user;  
selecting, from the parsed markup language document, markup language syntax corresponding to the physical position of the selected portion within the physical layout of the displayed content; and  
generating the content selection document to contain the selected markup language syntax.

(See claim 1...Basrur on parsed markup language and Currans (Detx 17)/col 8, lines 6-15... Once layout manager 516 has completed at least a partial layout of the publication, schedule manager 514 completes the publication layout (e.g., with last minute content objects, or updates to such objects), and schedules delivery of the personalized publication).

As per Claim 17:

Currans et al. discloses a system configured for selectively subscribing to content in a computing environment, comprising:

a computer comprising a processor (See Currans FIG. 1); and

instructions which execute using the processor to implement functions comprising:

responsive to selection, by a user from a view of content displayed on a graphical user interface from a source address, of a portion that comprises a subset of the displayed content

(see Currans (Detx 50)/col 15, lines 40-47.. As introduced above, this covert monitoring (via sensors, client application(s), etc.) records one or more of the distribution of content objects to a user, user receipt of content objects, whether the object(s) were printed or viewed on a display terminal, the duration viewed (if by terminal), whether any editing of the content object(s) occurred, and any other user interaction with the content object(s)...(in whole or in part). The Examiner is construing the responses the user makes can be partial, i.e a subset, some or portion of interaction with the content. For example, printing some or the content, viewing some of the content, editing some of the content, etc.), registering a subscription, for the user, to the selected portion of the content from the source address;

(see Currans FIG. 15 ..user registration and user subscription interests etc.); and  
and

subsequently evaluating an updated version of the content from the source address, using the content selection document, to create an updated version of the selected portion.

(See Currans FIGS. 5, 7, 8 regarding customized newspaper (updated documents), etc. for the user. FIG. 2..documents can be requested from other sources)

Currans et al. does not explicitly disclose parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document;

However Basrur discloses parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document;

(see Basrur para. [0019] The parser 112 is included in the data access driver 110 to parse the markup language documents 120, 122, 128 and in some embodiments, to modify or even create the documents 120, 122, 128).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document to the system of Currans et al.. One would have been motivated to do this in order to develop customized documents for customers.

As per Claim 21:

Currans et al. discloses a computer program product configured for selectively subscribing to content in a computing environment, the computer program product embodied on one or more computer- readable storage media and comprising computer- readable program code for:

responsive to selection, by a user from a view of content displayed on a graphical user interface from a source address, of a portion that comprises a subset of the displayed content

(see Currans (Detx 50)/col 15, lines 40-47.. As introduced above, this covert monitoring (via sensors, client application(s), etc.) records one or more of the distribution of content objects to a user, user receipt of content objects, whether the object(s) were printed or viewed on a display terminal, the duration viewed (if by terminal), whether any editing of the content object(s) occurred, and any other user interaction with the content object(s)...(in whole or in part). The Examiner is construing the responses the user makes can be partial, i.e a subset, some or portion of interaction with the content. For example, printing some or the content, viewing some of the content, editing some of the content, etc.).

registering a subscription, for the user, to the selected portion of the content from the source address;

(see Currans FIG. 15 ..user registration and user subscription interests etc.); and

and subsequently evaluating an updated version of the content from the source address, using the content selection document, to create an updated version of the selected portion.

(See Currans FIGS. 5, 7, 8 regarding customized newspaper (updated documents), etc. for the user. FIG. 2..documents can be requested from other sources)

Currans et al. does not explicitly disclose parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document;

However Basrur discloses parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document;

(see Basrur para. [0019] The parser 112 is included in the data access driver 110 to parse the markup language documents 120, 122, 128 and in some embodiments, to modify or even create the documents 120, 122, 128).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document to the system of Currans et al.. One would have been motivated to do this in order to develop customized documents for customers.

As per Claim 22:

Currans et al. discloses enabling the user to customize the subscription to specify at least one condition which must be matched before the user is interested in the updated version of the selected portion of the content and at least one action to be carried out when the at least one condition is matched in the updated version of the selected portion of the content; and wherein the registering further comprises registering the customization.

(see Currans (Detx 46)/col 14, lines 54-59 ... If content objects identified for publication have already been retrieved to satisfy another user request, construction agent 520 access local memory 508 to quickly retrieve the identified content objects, block 1425. Otherwise, in block 1430, construction agent 520 extracts the appropriate ones of the categorized content objects with which to generate a personalized publication); and

wherein the registering further comprises registering the customization (see Currans FIG. 7...personalized newspaper deliver 1:30 pm weekdays, and see FIG. 15 ...user registration and user subscription interests etc.

As per Claim 23:

Currans et al. discloses using the registered subscription to deliver the updated version of the selected portion of the content to the user when the updated version matches the at least one condition.

(see Currans (Detx 10)/ col 6, lines 13-18... controller(s) 502 selectively invoke one or more of the virtual editor 506 to generate a custom document for a requesting and/or subscribing user, or publishing agent 504 to complete the layout and optimize

the delivery schedule of such custom documents (Detx 46)/col 14, lines 54-59 ... If content objects identified for publication have already been retrieved to satisfy another user request, construction agent 520 access local memory 508 to quickly retrieve the identified content objects, block 1425. Otherwise, in block 1430, construction agent 520 extracts the appropriate ones of the categorized content objects (matching) with which to generate a personalized publication.

**4. Claims 5, 6, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Currans et al. (US 6731393), in view of Basrur (US 20040019589), and further in view of Messner et al. (US 20010043364).**

As per Claim 5:

Currans et al. does not explicitly disclose specifying, for the user in the registered subscription, at least one action to be carried out when the at least one condition is matched in an update the updated version of the identified selected portion of the content.

However, Messner et. al. discloses specifying, for the user in the registered subscription, at least one action to be carried out when the at least one condition is matched in an update the updated version of the identified selected portion of the content.

(see Messner FIG. 16...user promoted for input in the generation of the personalized lesson plan).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to add specifying, for the user in the registered subscription, at least one action to be carried out when the at least one condition is matched in an update the updated version of the identified selected portion of the content to the system of Currans et al.. One would have been motivated to do this in order to involve the user in the personalization process via prompts.

As per Claims 6, 24:

Currans et al. discloses evaluating the registered subscription, and if the at least one condition registered specified therein is met in an update to the updated version of the selected identified portion of the content, carrying out the at least one action. (see claim 5 regarding carrying out of the action via Messner et al., and Currans FIG. 7...personalized newspaper deliver 1:30 pm weekdays (updated content) ).

### **Response to Arguments**

The applicant's arguments are moot in light of the added citations. See claims 1, 17, and 21 for the art of record Currans on responding to (interacting with) a subset of displayed content. Currans col 15, lines 40-47 states "As introduced above, this covert monitoring (via sensors, client application(s), etc.) records one or more of the distribution of content objects to a user, user receipt of content objects, whether the object(s) were printed or viewed on a display terminal, the duration viewed (if by terminal), whether any editing of the content object(s) occurred, and any other user interaction with the content object(s)...(in whole or in part)". The Examiner is construing the responses the user makes can be partial, i.e a subset, some or portion of interaction



with the content. For example, printing some or the content, viewing some of the content, editing some of the content, etc.).

### **Conclusion**

Applicant's amendment and arguments necessitated additional citations made above in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Monday through Thursday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Namrata Boveja can be reached on 571-272-8105. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6102

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rmh

/Arthur Duran/

Primary Examiner, Art Unit 3682